THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 10

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte THOM R. HAYNES

Appeal No. 95-3744
Application 08/084,838[1]

ON BRIEF

Before HAIRSTON, JERRY SMITH and FLEMING, Administrative Patent Judges.

JERRY SMITH, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal under 35 U.S.C. § 134 from the examiner's rejection of claims 1-4, 6-13 and 15-18, which constitute all the claims remaining in the application.

The disclosed invention pertains to a method and apparatus for two-dimensionally scrolling data in the client area of a window on the user interface of a data processing system. Conventionally in a data processing system, scrolling of data within a window is performed by

[1] Application for patent filed June 29, 1993.

scrolling separately in a horizontal direction or a vertical direction on a display screen. The instant invention provides an object as part of the window which can be dragged in any direction and the contents of the window will be scrolled in that direction.

Representative claim 1 is reproduced as follows:

1. A method of two-dimensionally scrolling data in a client area of a window on a user interface of a data processing system, comprising the steps of:

a) providing an object included as a part of said window, said object occupying a home position;

b) allowing a user to move said object in a composite direction from said home position, said composite direction comprising a first directional component and a second directional component, said second directional component being orthogonal to said first directional component; and

c) scrolling said data in said client area in said composite direction.

The examiner cites the following references in the examiner's answer:

Yanker	5,075,673	Dec. 24, 1991
Steele et al. (Steele)	5,169,342	Dec. 08, 1992
Meier et al. (Meier)	5,196,838	Mar. 23, 1993
Paal et al. (Paal)[2]	5,263,134	Nov. 16, 1993 (filed July 30, 1992)
Apple (Canadian Patent)	2,059,893	Sep. 13, 1992

Microsoft® Windows$_{TM}$ User's Guide (Windows), copyright 1990-1992, pages 386-388.

[2] Although Paal is listed in the examiner's answer as prior art relied upon, none of the rejections formulated by the examiner makes reference to Paal in the statement of the rejection or in the analysis. We will have further comments on Paal at the end of this decision.

Claims 1-4, 6-13 and 15-18 stand rejected under 35 U.S.C. § 103. As evidence of obviousness the examiner offers Yanker in view of Steele with respect to claims 1, 4, 10 and 13, adds Meier with respect to claims 2, 3, 6, 11, 12 and 15, and further adds Windows with respect to claims 7 and 16. The examiner combines the teachings of Yanker with Steele and Apple to support the rejection of claims 8, 9, 17 and 18.

Rather than repeat the arguments of appellant or the examiner, we make reference to the brief and the answer for the respective details thereof.

OPINION

We have carefully considered the subject matter on appeal, the rejections advanced by the examiner and the evidence of obviousness relied upon by the examiner as support for the rejections. We have, likewise, reviewed and taken into consideration, in reaching our decision, the appellant's arguments set forth in the brief along with the examiner's rationale in support of the rejections and arguments in rebuttal set forth in the examiner's answer.

It is our view, after consideration of the record before us, that the collective evidence relied upon and the level of skill in the particular art would not have suggested to one of ordinary skill in the art the obviousness of the invention as set forth in claims 1-4, 6-13 and 15-18. Accordingly, we reverse.

In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the examiner to establish a factual basis to support the legal conclusion of obviousness. See In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986); ACS Hospital Systems, Inc. v. Montefiore Hospital, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the examiner are an essential part of complying with the burden of presenting a prima facie case of obviousness. Note In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). We now consider how these rules apply to the claims on appeal.

Claims 1, 4, 10 and 13 stand rejected based on Yanker in view of Steele. Yanker teaches a display apparatus in which a large world-plane image is viewed in smaller portions through a viewport 40. A cursor within viewport 40 can be dragged outside the viewport, and the viewport image will pan in the direction of the nearest border. The distance at which the cursor is moved

beyond the viewport boundary determines the speed at which the world-plane image will be panned [column 1, line 64 to column 2, line 5]. Steele teaches a graphical user interface in which a dragged icon will be returned to its "home" position when it has been moved a small distance with respect to its size [column 9, lines 6-10].

Appellant argues that Yanker's cursor 50 is not part of the viewport, and the Yanker cursor does not have a home position [brief, page 5]. The examiner responds that the entire viewport 40 is considered to be the claimed home position, and that this interpretation meets the language of claim 1. Although we can agree with the examiner that Yanker can be interpreted in this manner, such interpretation does not suggest the claimed invention.

Claim 1 recites that the scroll direction must be in the same composite direction that the object is moved. Regardless of the direction in which the cursor 50 of Yanker is moved outside the viewport 40 or home area, the pan occurs in either a horizontal direction or a vertical direction depending on which boundary is closest to the cursor. The examiner has belatedly argued that if the Yanker cursor were moved at a diagonal outside a corner of its home viewport, it would cause scrolling both in a horizontal and vertical direction [answer, page 8]. We are unable to find any support in Yanker for this assertion of the examiner. Yanker only desribes panning in a single direction toward the closest boundary. While in theory a movement of cursor 50 at a 45 degree angle away from one of the viewport corners would make two boundaries equally close, Yanker never suggests this as a possibility. The examiner's position is pure speculation based on trying to achieve in hindsight what appellant has done. Thus, Yanker does

not provide the fundamental teaching of panning or scrolling in the same composite direction that an object is moved.

The examiner also contends that a scroll in one direction followed by a scroll in another direction results in the scrolling in a composite direction with respect to the initial location. While this is true, it is not relevant to the claimed invention. The admitted prior art has always been able to achieve a resultant scroll in any direction by performing a horizontal scroll followed by a vertical scroll or vice versa. As noted above, however, claim 1 requires that the scroll itself occur in the composite direction, and not simply result in a data movement in the composite direction. The examiner's finding of facts regarding the teachings of Yanker simply are not supported by the Yanker disclosure.

The whole point of appellant's invention is to permit the scroll to occur in a composite direction, not simply to end up in a composite direction from the initial point. Although claim 1 does not specifically recite that the scroll occurs in two orthogonal directions simultaneously, the language of claim 1 implicitly makes this requirement. The scroll can only occur in the same composite direction as the object is moved if it tracks the directional movement of the object. This can only occur if the scroll takes place in both orthogonal directions at the same time.

For reasons noted above, Yanker in no way suggests the scrolling of data in a composite direction as required by independent claims 1 and 10. Even though additional references are cited against the dependent claims, none of the additional references makes up for the basic deficiency in the Yanker teaching. Therefore, we do not sustain any of the rejections made by the examiner.

As we noted supra, the examiner cited a patent to Paal but never applied it in the rejections. Paal was first cited in the final rejection with the comment "Paal et al., U.S. Patent No. 5,263,134, teaches two-dimensional scrolling" [page 10]. We agree that Paal teaches simultaneous two-dimensional scrolling along any composite direction. For example, Paal teaches that a symbol 52 can be moved in a composite direction, and the active window 53 will dynamically scroll in the same direction that the object is moved [column 10, line 64 to column 11, line 26]. In view of our discussion of the examiner's rejections above, it is clear that Paal represents the closest prior art cited by the examiner. Thus, it would appear that any appropriate rejections on this record should be based upon Paal as the principal reference.

Having made this observation, we simply invite the examiner to consider whether any of the pending claims are obvious in view of all the cited prior art. Since appellant has argued essentially every limitation of the claims as patentably distinguishing over the applied prior art, we do not wish to prejudge the issue of obvousness by initiating a rejection before appellant has

had an opportunity to present a position with respect to Paal. Thus, we simply note that Paal is the closest prior art, and the record in this case should reflect how Paal affects the patentability of the pending claims.

In order to assist the examiner and appellants should prosecution of this invention be resumed, we offer the following comments on the teachings of the other prior art applied by the examiner. It would not have been obvious to combine Steele with Yanker for the purpose of returning the cursor in Yanker to its home position. The Steele teachings which relate to returning an icon after slight movement would not have suggested its use in a movement of the type claimed here or desired in Yanker. Meier would have rendered obvious the broad recitation of stopping scrolling by releasing an object. Yanker would have rendered obvious the broad recitation of scrolling data at a rate determined by the distance of an object from a home position. Windows would not have suggested the toggling of scroll bars as the toggling is recited in claims 7 and 16. Apple would have rendered obvious the broad recitation of moving scroll buttons along scroll bars as the data within a window is scrolled.

For all the reasons discussed above, the examiner's rejection of claims 1-4, 6-13 and 15-18 is reversed.

REVERSED

KENNETH W. HAIRSTON Administrative Patent Judge	)
JERRY SMITH Administrative Patent Judge	) BOARD OF PATENT) APPEALS AND) INTERFERENCES
MICHAEL R. FLEMING Administrative Patent Judge	)

GEOFFREY A. MANTOOTH
WOFFORD, FAILS, ZOBAL & MANTOOTH
110 WEST SEVENTH
STE. 500
FORT WORTH, TX 76102